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Application Serial No.: 09/760,085

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To: Examiner Joyce Tung

Company: U.S. Patent and Trademark Office

From: Mary L. Miller

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Comments:

Per my voice message today Re: case law for application serial no. 09/760,085 to be discussed during 09/10/03 telephone interview.

Thank you,
Mary L. Miller

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years' worth of license fees, or \$1,260, since the date of its first letter to defendants on September 23, 1933 informing them that they were required to sign a license agreement. By imposing the statutory minimum of \$500 per number of works infringed,³ defendants will be required to pay \$11,500, approximately nine times the amount defendants would have paid in licensing fees. This Court finds that to be an appropriate penalty for the defendants' infringements.

Finally, the Copyright Act provides that the court "in its discretion may allow the recovery of full costs [and] may also award a reasonable attorney's fee to the prevailing party as part of the costs." 17 U.S.C. § 505. In order to encourage suits to redress copyright infringement, attorney fees are awarded to a prevailing plaintiff as a matter of course. *Frost Belt Int'l Recording Enterprises, Inc. v. Cold Chillin' Records*, 758 F.Supp. 131, 140 (S.D.N.Y. 1990) The award of attorney's fees is the rule rather than the exception. *Micromanipulator Co. v. Bough*, 779 F.2d 255, 259 [228 USPQ 443] (5th Cir. 1985). Consequently, this Court finds plaintiffs entitled to reasonable attorney's fees for the prosecution of this action.

The declaration of Marjorie R. Esman submitted by plaintiffs states that plaintiffs incurred \$1,747.00 in attorney's fees for services, including: preparation and service of discovery materials, participation in a scheduling conference; preparation of and filing of a witness and exhibit list; preparation and filing of the motion for summary judgment. The declaration states that plaintiffs incurred costs and expenses in the amount of \$485.37 for filing of the complaint, payments to the process server, reasonable photocopies, and long distance telephone charges. This Court finds these declared attorneys' fees, costs and expenses to be reasonable.

Conclusion

For the reasons set forth above,
IT IS ORDERED that plaintiffs' motion for summary judgment is hereby GRANTED in all respects except plaintiffs' request

³ See *Frank Music Corp. v. Metro-Goldwyn-Mayer Inc.*, (9th Cir.), 886 F.2d 1545 [12 USPQ2d 1412], cert. den'd 110 S.Ct. 1321, 494 U.S. 1017 (1989) which states that the number of works infringed is the appropriate calculation for statutory damages and not the number of infringements. The affidavit of James Hutcherson, investigator for BMI, lists 23 works which were

for statutory damages in the amount of \$2,500 per claim of infringement. Accordingly, defendants are liable to plaintiffs in the amount of \$11,500 in statutory damages for copyright infringements, \$1,747.00 in attorney's fees, and \$485.37 in costs and expenses. Judgment will be so entered.

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Ex parte Parks

No. 93-2740

Decided September 2, 1993
Released January 4, 1994

PATENTS

1. Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Patentability/Validity — Specification — Written description (§115.1103)

Claims in reissue application for method of determining nitrogen content of sample were improperly rejected on ground of inadequate descriptive support under 35 USC 112, first paragraph, since originally-filed disclosure need only convey, to one of skill in art, that applicant had possession of concept of what is claimed in order to satisfy description requirement, since lack of literal basis in disclosure for limitation that decomposition step of claims be "conducted in the absence of a catalyst" thus does not establish prima facie case for lack of descriptive support, and since it cannot be held that originally-filed disclosure would not have conveyed concept of effecting decomposition at elevated temperature in absence of catalyst.

2. Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Claims in reissue application for method of determining nitrogen content of sample are overbroad under 35 USC 251, since application was filed more than two years after grant of original patent, since any claim which does not contain negative limitation expressly excluding presence of catalyst in decomposition step of method is broader than original claims, and since claims in question do not accomplish such exclusion by reciting phrase "consisting essentially of" in characterizing decomposition step.

Particular patents — Chemical — Nitrogen detection

4,018,562, Parks and Marietta, chemiluminescent nitrogen detection apparatus and method, claims 81-93 in application for reissue rejected.

Appeal from final rejection of claims in application for reissue of patent (Jill Johnston, primary examiner).

Application of Robert E. Parks and Robert L. Marietta, serial no. 708,810, filed May 31, 1991, continuation of serial no. 340,540, filed April 18, 1989 and abandoned, for reissue of patent no. 4,018,562, granted April 19, 1977 on application serial no. 625,510, filed Oct. 24, 1975 (chemiluminescent nitrogen detection apparatus and method). From final rejection of all claims in application, applicants appeal. Rejection of claims 1-10, 20-22, 55-80, and 94-106 reversed; rejection of claims 81-93 affirmed.

Before Calvert, vice chairman, and Steiner and Tarring, examiners-in-chief.

Steiner, examiner-in-chief.

This is an appeal from the final rejection of claims 1 through 10, 20 through 22 and 55 through 106, all the claims in this application for reissue of Patent No. 4,018,562 (the '562 patent).

THE INVENTION

The claimed invention is a method for determining the nitrogen content of a sample comprising manipulative steps which include decomposing the sample in an oxygen/inert gas atmosphere at an elevated temperature to obtain nitric oxide and causing the generated nitric acid to undergo a chemiluminescent reaction with ozone.

Claims 1, 81 and 94 are illustrative and read as follows:

1. The method for determining the total chemically combined nitrogen content of a sample comprising the steps:

a. decomposing said sample in one step in the presence of an oxygen-rich atmosphere of oxygen and an inert gas and at a temperature sufficiently above 700°C. that substantially all of the chemically bound nitrogen is recovered as nitric oxide (NO), such decomposition being conducted in the absence of a catalyst,

b. causing the nitric oxide produced by such decomposition to undergo a chemiluminescent reaction with ozone, and

c. determining the magnitude of the chemiluminescent reaction to indicate the quantity of chemically combined nitrogen in said sample.

81. A method for determining the total chemically combined nitrogen content of a sample, said method comprising the steps of:

(a) decomposing said sample in one step, said decomposing step consisting essentially of decomposing said sample in the presence of an oxygen-rich atmosphere of oxygen and an inert gas and at a temperature sufficiently above 700°C that substantially all of the chemically bound nitrogen is recovered as nitric acid (NO);

(b) causing the nitric oxide produced by such decomposition to undergo a chemiluminescent reaction with ozone; and

(c) determining the magnitude of the chemiluminescent reaction to indicate the quantity of chemically combined nitrogen in said sample.

94. A method for determining the total chemically combined nitrogen content of a sample, said method comprising the steps of:

(a) decomposing said sample in one step in the presence of an oxygen-rich atmosphere of oxygen and an inert gas and at a temperature sufficiently above 700°C that substantially all of the chemically bound nitrogen is recovered as nitric oxide (NO) according to the formula:



(b) causing the nitric oxide produced by such decomposition to undergo a chemiluminescent reaction with ozone; and

(c) determining the magnitude of the chemiluminescent reaction to indicate the quantity of chemically combined nitrogen in said sample.

THE REJECTIONS

Claims 1 through 10, 20 through 22 and 55 through 80 stand rejected under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support. Claims 81 through 106 stand rejected under 35 U.S.C. 251 in that they are broader than the originally patented claims.¹ In addition, all the

¹ The ultimate paragraph of 35 U.S.C. 251 reads as follows:

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

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appealed claims stand rejected under 35 U.S.C. 251 for lack of the requisite "error."

The rejection under the first paragraph of 35 U.S.C. 112, the rejection of claims 94 through 106 under 35 U.S.C. 251 as broader than the original claims, and the rejection of all the appealed claims under 35 U.S.C. 251 for lack of the requisite "error" are reversed; the rejection of claims 81 through 93 under 35 U.S.C. 251 as broader than the original claims is affirmed.

OPINION

The Rejection of Claims 1 through 10, 20 through 22 and 55 through 80 under the first paragraph of 35 U.S.C. 112.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

[1] The examiner contends that the rejected claims lack adequate descriptive support because there is "no *literal* basis for the" claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. *In re Herschler*, *supra*; *In re Edwards*, *supra*; *In re Wertheim*, *supra*.

The examiner notes that in *Parks v. Fine*, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), involving the claimed subj ct matter, the limitation "in the absence of a catalyst" was considered material. Suffice it to say, no issue under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support for the limitation "in the absence of a catalyst" was before the court.

We are not unmindful of the decision in *Ex parte Grasselli*, 231 USPQ 393 (Bd.App. 1983) *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984), which involved claims to a process for the ammoxidation of propane or isobutane employing a catalyst "free of uranium and the combination of vanadium and phosphorus." Under the particular facts in that case, it was held that the negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. 112, citing *In re Anderson*, *supra*. In the situation before us,³ it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst. See, for example, column 5 of the '562 patent, first paragraph, wherein FIG. 4 is discussed. Pyrolysis temperatures of between 600°C and 700°C, and above 700°C were employed to achieve conversion of chemically bound nitrogen to nitric oxide. Smooth conversion was obtained above 700°C, while the optimum conversion was found to occur above 900°C. Throughout the discussion which would seem to cry out for a catalyst if one were used, no mention is made of a catalyst.⁴

Moreover, according to two declarations by Wentworth, a professor of chemistry at the University of Houston, whose expertise in this particular art has not been challenged, one having ordinary skill in the art would have recognized that the reaction generating nitric oxide, according to the equation disclosed in the '562 patent, is conducted without a catalyst. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d

³ Whether the requirement for an adequate written description has been met is a question of fact and, hence, driven by the exigencies of each case. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

⁴ A "catalyst" normally functions to accelerate a particular reaction. See for example, Hawley, *Condensed Chemical Dictionary*, Tenth Edition, 1981, pp. 205 and 206, copies of which are enclosed for appellants' convenience and made of record.

² See page 4 of the Answer, second full paragraph, last two lines.

1111 (Fed. Cir. 1991); *In re Lemin*, 364 F.2d 864, 150 USPQ 546 (CCPA 1966). Thus, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art the concept of effecting decomposition at an elevated temperature in the absence of a catalyst. *In re Anderson*, *supra*.

Accordingly, the examiner's rejection of claims 1 through 10, 20 through 22 and 55 through 80 under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support is reversed.

The Rejection of Claims 81 through 106 under 35 U.S.C. 251 as Broader than the Original Claims.

We initially observe that on page 6 of the Brief,

appellants agree that any claim in the reissue application that does not contain a limitation that means "in the absence of a catalyst" is broader than original claims 1-10 and hence unpatentable under 35 USC 251 (appellants' emphasis).

Claims 81 through 106 do not contain a negative limitation which expressly precludes the presence of a catalyst. However, appellants contend that claims 81 through 93 exclude the presence of a catalyst by virtue of the phrase "consisting essentially of" in characterizing the decomposition step, and that claims 94 through 106 exclude the presence of a catalyst by virtue of the recited equation for the decomposition reaction, which equation does not reflect the presence of a catalyst.

[2] In our opinion, the phrase "consisting essentially of," as employed in claims 81 through 93, limits decomposition to a single step and, in that sense, is redundant since decomposition is performed "in one step." However, it is not apparent and appellants have not explained why the expression "consisting essentially of" excludes the presence of a catalyst during the recited decomposition step.¹ It would, therefore, appear that claims 81 through 93 are broader than original claims 1 through 10 and, hence, were properly rejected by the examiner under 35 U.S.C. 251. Accordingly, the examiner's rejection of claims 81 through 93 under 35 U.S.C. 251 is affirmed.

Claims 94 through 106 recite the decomposition reaction in a manner which, according to the Wentworth declarations, means that no catalyst was employed. *In re Lemin*,

supra. Accordingly, claims 94 through 106 would not appear broader than original claims 1 through 10 and, hence, the examiner's rejection of claims 94 through 106 under 35 U.S.C. 251 is reversed.

The Rejection of the Appealed Claims Under 35 U.S.C. 251 for Lack of the Requisite Error.

This rejection is reversed essentially for the reasons advocated by appellants on appeal. We emphasize that the practice of submitting claims as a hedge against the possible invalidity of original claims has been judicially sanctioned. See, for example, *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 11 USPQ2d 1750 (Fed. Cir. 1989); *In re Altenpohl*, 500 F.2d 1151, 183 USPQ 38 (CCPA 1974); *In re Handel*, 312 F.2d 943, 136 USPQ 460 (CCPA 1963).

In summary, the examiner's rejection of claims 81 through 93 is affirmed; the rejection of claims 1 through 10, 20 through 22, 55 through 80 and 94 through 106 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED-IN-PART.

**U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences**

Ex parte Heymes

No. 93-1646

Decided November 9, 1993

Released January 4, 1994

PATENTS

1. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Patentability/Validity — Obviousness — Secondary considerations generally (§115.0907)

Application claims for chemical compounds were properly rejected as obvious under 35 USC 103, since claims are *prima facie* obvious in view of cited references, since record does not show that claimed compounds, which are intermediates to patented compounds having antibiotic properties, have no known utility other than as

¹ Compare *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805, 812, note 6 (Fed. Cir. 1986).